

### **Remarks**

The following remarks are submitted to address the issues raised in the Office Action mailed March 25, 2004.

Claims 1-7 and 11-62 are pending in the present application.

Claims 2-7, 11, 13-17, 19, 21-60 and 62 are held withdrawn.

Claims 8-10 are canceled.

Claims 1 and 61 stand rejected under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,922,770 to Peschke et al.

Claims 12, 18, and 20 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim.

No new matter has been added. The foregoing rejections and other items in the Office Action are addressed in the following paragraphs. Consideration of the pending claims is respectfully requested in view of the following comments.

### **Amendments**

Claims 12, 18, and 20 have been amended to depend from claim 61.

### **Withdrawn Claims**

In the Office Action mailed July 29, 2003, the Examiner withdrew claims 2-7, 11, 13-17, 19-40, 46-48, 52-55, and 57-60 from consideration after Applicants elected the compound of Example 8.

Applicants requested that the Examiner reinstate claim 20, and in the Office Action mailed March 25, 2004, the Examiner reinstated claim 20. The Examiner also withdrew

from consideration claims 41-45, 49-51, 56 and 62. Claims 41-45 are drawn to a pharmaceutical composition comprising the compound of Formula (I). Claims 49-51 and 56 are drawn to a method using the compound of Formula (I). Claim 62 is drawn to compounds of Formula (I).

Applicants respectfully request that the Examiner reinstate claims 41-45. Claims 41-45 are dependent on claim 1 and are drawn to a pharmaceutical composition comprising the compound of Formula (I). During the course of prosecution, the Examiner has cited references describing specific compounds and pharmaceutical formulations such as US 5,153,226, 5,795,907, and 5,922,770. Applicants respectfully submit that claims 41-45 fall within the scope of the subject matter examined by the Examiner.

Applicants respectfully request that the Examiner reinstate claim 62. Claim 62 is dependent on claim 61, and the genus of compounds described in claim 62 encompasses non-heterocyclic fluorenyl containing urethanes not further ortho-fused, sulfur, nitro, or silicon substituted. Applicants respectfully submit that the subject matter of claim 62 falls within the scope of the subject matter examined by the Examiner.

**Claims 1 - 35 U.S.C. § 102(b)**

Applicants respectfully traverse the rejection of claims 1 and 61 under 35 U.S.C. § 102(b) as being anticipated by US Patent No. 5,922,770 to Peschke et al. Applicants submit that the compounds disclosed in Peschke do not fall within the scope of the genus of compounds recited in claims 1 and 61. For example, the compound drawn in the middle of col. 94 of Peschke ( $\{[2-(2-(\text{methylamino})\text{ethyl})\text{phenylcarbonyl}]\text{methyl}\}$  carbamic acid 9H-((fluoren-9-yl)methyl)ester) does not fall within the scope of the genus of compounds recited in claims 1 and 61. Referring to claim 1, the compound of Formula (I) must have at least one side chain at the  $R_1$  and  $R_2$  position, because  $R_2$  does not include the possibility of being a

hydrogen. The compound in col. 94 of Peschke has only hydrogens at the same relative position.

**Claims 12, 18, and 20 - Objection**

Claims 12, 18, and 20 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim. Applicants respectfully traverse the objection to claims 12, 18, and 20.

Claims 12, 18, and 20 depend from claim 61 and ultimately depend from claim 1. As described above, Applicants have traversed each and every rejection of claim 61.

**Fees**

This complete response is being filed within 3 months of the mailing of the Office Action on March 25, 2004. As a result, no fee is believed to be due.

**Conclusion**

In conclusion, Applicants request entry of the Amendments, consideration of the Remarks, and passage of the application to issuance.

Respectfully submitted,

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